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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,102	12/05/2001	Ronald C. Card	80398P488	8971
8791 7590 10/03/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040			EXAMINER LASTRA, DANIEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/021,102		CARD, RONALD C.	
	Examiner		Art Unit	
	DANIEL LASTRA		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/20/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-60 have been examined. Application 10/021,102 (SYSTEM AND METHOD TO PROVIDE FINANCIAL REWARDS AND OTHER INCENTIVES TO USERS OF PERSONAL TRANSACTION DEVICES) has a filing date 12/05/2001 and Claims Priority from Provisional Application 60254382 (12/07/2000).

Response to Amendment

2. In response to Non Final Rejection filed 03/22/2007, the Applicant filed an Amendment on 06/20/2007, which amended claims 1, 19, 31 and 43.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 18-26, 30-38, 42-56 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 6,999,943) in view of Arent (US 6,018,724).

Claims 1, 19, 31 and 43, Johnson teaches:

A method comprising:

processing a plurality of transactions between a personal transaction device and at least one vendor connected to said personal transaction device (see col 10, lines 60-65; col 25, lines 57-62; col 26, lines 23-27); and

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determining vendor incentives for said at least one vendor (see col 12, lines 5-50) and user incentives for a user connected to said personal transaction device (see col 9, lines 25-40; col 10, lines 60-65; col 24, lines 20-45) based on each transaction of said plurality of transactions (see col 9, lines 29-40). Johnson fails to teach *rewarding said user for using said personal transaction device*. However, Arent teaches using a personal transaction device (*i.e.* digital wallet) to store transactions instruments (*i.e.* credit, debit, e-cash) and coupons in addition to other types of incentives and rewards (see Arent col 11, lines 15-30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time application was made, to know that Johnson's users would use digital wallets to store different payment instruments and incentives or rewards, as taught by Arent in order to help issuers have better control over which transactions they processed, as digital wallets would be used to store all the information necessary to process the most profitable transaction between a user and a vendor.

Claims 2, 20, 32 and 44, Johnson teaches:

The method according to claim 1, wherein said processing further comprises:

receiving each transaction of said plurality of transactions (see col 9, lines 30-40; col 18, lines 55-67); and

storing a plurality of user characteristics related to said each transaction in a user profile within a user database (see col 18, lines 55-67).

Claims 3 and 45, Johnson teaches:

The method according to claim 2, wherein said plurality of user characteristics further comprises purchasing preferences of said user (see col 18, lines 55-60).

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Claims 4 and 46, Johnson teaches:

The method according to claim 2, wherein said plurality of user characteristics further comprises financial information related to said user (see col 18, lines 65-67).

Claims 5 and 47, Johnson teaches:

The method according to claim 2, wherein said plurality of user characteristics further comprises a transaction history of said user (see col 18, lines 57-60).

Claims 6, 21, 33 and 48, Johnson teaches:

The method according to claim 1, further comprising:

updating a vendor account within a user database with a predetermined incentive related to said each transaction of said plurality of transactions (see col 10, lines 55-60); and updating a user award account within said user database with a predetermined user incentive after said each transaction is processed (see col 9, lines 30-40; col 24, lines 60-67).

Claims 7 and 49, Johnson teaches:

The method according to claim 6, wherein said predetermined incentive is a fee paid subsequent to each use of said personal transaction device to complete said each transaction (see col 12, lines 1-50).

Claims 8 and 50, Johnson teaches:

The method according to claim 6, wherein said predetermined incentive is a rate charged for purchasing information related to said user and requested by said at least one vendor (see col 12, lines 1-50).

Claims 9 and 51, Johnson teaches:

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The method according to claim 6, wherein said predetermined incentive is a rate charged for advertising (see col 27, lines 40-60).

Claims 10, 22, 34 and 52, Johnson teaches:

The method according to claim 1, further comprising: transmitting said vendor incentives to said at least one vendor, if a vendor account stored within a user database and containing said vendor incentives is equal to a predetermined vendor incentive value (see col 12, lines 1-50).

Claims 11, 23, 35 and 53, Johnson teaches:

The method according to claim 1, further comprising:

notifying said user through said personal transaction device that said user incentives are available, if a user award account stored within a user database and containing said user incentives is equal to a predetermined user award value (see col 9, lines 30-40 "award points").

Claims 12, 24, 36 and 54, Johnson teaches:

The method according to claim 11, further comprising: retrieving a user profile from said user database; adapting said user incentives to said user profile; and transmitting said user incentives to said personal transaction device (see col 18, lines 45-67).

Claims 13, 25, 37 and 55, Johnson teaches:

The method according to claim 11, further comprising automatically transmitting said user incentives to said personal transaction device (see col 9, lines 30-45).

Claims 14, 26, 38 and 56, Johnson teaches:

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The method according to claim 11, further comprising:

transmitting a message to said personal transaction device describing said user incentives (see col 14, lines 40-45);

receiving a reply message from said personal transaction device, said reply message containing a selection of a selected user incentive of said user incentives; and transmitting said selected user incentive to said personal transaction device (see col 14, lines 40-45).

Claims 18, 30, 42 and 60, Johnson and Arent do not expressly teach:

notifying said at least one vendor that said user incentives are available, if a user award account stored within a user database and containing said user incentives is equal to a predetermined user award value. However, Official Notice is taken that it is old and well known in the promotion art to notify a vendor or a user of an available incentive when said user award account (*i.e.* points) reached a predetermined threshold in order that said user redeems an award. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Johnson and Arent would notify a user and a vendor when said user's award account balance reached a predetermined threshold amount in order that said user redeems an award.

4. Claims 15-17, 27-29, 39-41 and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 6,999,943) in view of Arent (US 6,018,724) and Kolls (US 6,609,103).

Claims 15, 27, 39 and 57, Johnson and Arent does not expressly teach:

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wherein said message prompts said user to select said selected user incentive from an incentive list containing said user incentives. However, Kolls teaches that it is old and well known in the promotion art to allow users to select earned incentives from a list of incentives using a portable device (see col 51, lines 1-40). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Johnson and Arent would allow users to select an incentive from a list of incentive using a portable device, as it is old and well known to do so, as taught by Kolls.

Claims 16, 28, 40 and 58, Johnson does not expressly teach:

wherein said message prompts said user to select or decline receipt of said user incentives. However, Kolls teaches that it is old and well known in the promotion art to allow users to select earned incentives from a list of incentives using a portable device. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Johnson and Arent would allow users to select an incentive from a list of incentive using a portable device, as it is old and well known to do so.

Claims 17, 29, 41 and 59, Johnson does not expressly teach:

transmitting an incentive list containing said user incentives to said personal transaction device; receiving a selection of a selected user incentive from said personal transaction device and transmitting said selected user incentive to said personal transaction device. However, Kolls teaches that it is old and well known in the promotion art to allow users to select earned incentives from a list of incentives using a portable

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device. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Johnson and Arent would allow users to select an incentive from a list of incentive using a portable device, as it is old and well known to do so.

Response to Arguments

5. Applicant's arguments with respect to claims 1-60 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra

September 12, 2007


RAQUEL ALVAREZ
PRIMARY EXAMINER